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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,587	08/22/2003	Sam Park	A364-JN-CIP	9954

7590

06/01/2004

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/646,587

Applicant(s)

PARK, SAM

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-12 and 15-18 is/are rejected.
- 7) ☒ Claim(s) 7-9, 13, 14, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

This Office action is responsive to communication received 08/22/2003 – application papers filed.

This application is a CIP of 10/373,502, filed 02/24/2003, pending.

Claims 1-20 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4 and 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Brill. As to claims 1 and 10, note shaft (2) and head (1), including a ball hitting surface (5) and a rearwardly extending portion comprising side sections (4). A bottom aperture is defined by the bottom of the sidewall portions. A ball placed within

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the rear cavity shown in Brill clearly is viewable from the top and is allowed to protrude partially outward through the bottom aperture (see Figure 3). As to claims 2 and 11, a golf ball placed within the cavity is fully capable of rolling in only one direction. The ball may clearly be removed. As to claim 4, note Figure 3 showing a downwardly sloped taper on the bottom surface at the edges where the bottom aperture is formed.

Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brill in view of Byrne and DeVries. Brill lacks a ball having a broken line. DeVries and Byrne show it to be old to provide golf balls with indicia that enables a golfer to more clearly note the direction of roll of the ball. See Figure 2 in DeVries, for example. In addition, the prior art shows it to be old to correlate markings on a golf ball with the markings on the top surface of a club head in order to provide a more accurate line of sight. See Figure 1 in Byrne, for instance. In view of the patents to DeVries and Byrne, it would have been obvious to modify the device in the cited art reference to Brill by providing the golf ball with a broken line markings, the motivation being to enable a golfer to more easily identify the direction that a ball is traveling with respect to the plane of the strike face and with respect to an intended line of putt.

Claims 1, 2, 5, 6, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hale. Note arms (22, 24) that are removable from the head portion and which serve to confine a golf ball there between. The ball (18) is fully capable of rotating in only one direction (note arrows indicating rotation in Figures 6A-6D).

Claims 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Middleton. Note shaft (30) and head (2). The head (2) includes a top and bottom

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portion with an aperture (14) extending through the top and bottom. A ball (82) is retained within the head and protrudes outward through the top and bottom of the head through the aperture. The ball (82) is fully capable of rolling only in the direction of putt. Note Figures 2C and 2D, showing detachable rearwardly extending portions.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton in view of Byrne and DeVries. Middleton lacks a ball having a broken line. DeVries and Byrne show it to be old to provide golf balls with indicia that enables a golfer to more clearly note the direction of roll of the ball. See Figure 2 in DeVries, for example. In addition, the prior art shows it to be old to correlate markings on a golf ball with the markings on the top surface of a club head in order to provide a more accurate line of sight. See Figure 1 in Byrne, for instance. In view of the patents to DeVries and Byrne, it would have been obvious to modify the device in the cited art reference to Middleton by providing the golf ball with a broken line markings, the motivation being to enable a golfer to more easily identify the direction that a ball is traveling with respect to the plane of the strike face and with respect to an intended line of putt.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hale in view of Byrne and DeVries. Hale lacks a ball having a broken line. Note, Hale does recognize the benefit of including a sight line (28). DeVries and Byrne show it to be old to provide golf balls with indicia that enables a golfer to more clearly note the direction of roll of the ball. See Figure 2 in DeVries, for example. In addition, the prior art shows it to be old to correlate markings on a golf ball with the markings on the top surface of a club head in order to provide a more accurate line of sight. See Figure 1 in Byrne, for

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instance. In view of the patents to DeVries and Byrne, it would have been obvious to modify the device in the cited art reference to Hale by providing the golf ball (18) with broken line markings and the top part of the head with a sight line, the motivation being to further enable a golfer to more easily identify the direction that a ball is traveling with respect to the plane of the strike face and with respect to an intended line of putt.

Claims 15, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brill. The patent to Brill shows every feature claimed with the exception of a detachable rearwardly extending portion. The very fact that the Brill device is integral does not preclude its consisting of various elements. It has long been held that to make separable that which was once made integral would have been within the level of one of ordinary skill in the art at the time of the invention. See Nerwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969). In this case, to have fashioned the rearwardly extending portion in Brill from a plurality of pieces would have involved nothing more than an obvious change in engineering design.

Claim 10 is objected to because of the following informalities: In line 11, clarification is requested for the term "conventional". Or, the term should simply be deleted. Appropriate correction is required.

Claims 7-9, 13, 14, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant is respectfully reminded to maintain a clear line of demarcation between the instant claims and the claims in the copending application serial no:

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10/373,502 in order to avoid the need to address any future possible issues of double patenting.

All references cited during prosecution of applicant's parent file are deemed pertinent to this instant application and are incorporated herein by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
May 26, 2004